Remarks:

Interview Summary:

Applicant James W. Wieder had an Interview with examiner Daniel L. Greene on Nov 19, 2008 beginning at ~1pm in the USPTO Knox building. Examiner Sarah Monfeldt was also present during part of the Interview. Prior to the Interview, the Applicant had faxed a summary to examiner Daniel L. Greene. Much discussion was held on the faxed summary and the prior art ["Conkwright].

No agreement on the claims was reached during the Interview. The Applicant would like to thank both examiners for the helpful Interview discussion.

Comments on the 101 Rejections:

Claims are not a Purely Human Mental Process:

In prior Office Actions, the Office had rejected the claims for being a Human Mental Process. The applicant traverses for at least the following reasons. The Human Process does not have at least the following elements/features "capturing, at a user-device" and "storing in one or more memories".

Claims recite a Machine Implementation:

The Office Action had rejected claims 163-202 under U.SC. 101 "because the claimed invention is directed to non-statutory subject matter". The applicant traverses for at least the following reasons. The method claims have been amended to clarify a machine-implemented method.

Discussion of "Conkwright" Reference:

Conkwright is probably best appreciated, at a high level, from its figure 25 and the related discussion of figure 25 in the Conkwright specification. The attached "Exhibit A" ("Conkwright Approach") is provided as a "quick" visual summary of Conkwright. "Exhibit A" was created by starting with figure 25 from the Conkwright patent (7,146,329). The applicant added the descriptive comments onto that Conkwright figure 25 to provide a summary of the description in the Conkwright specification.

In Conkwright box 2500 (figure 25), set top box events are used to determine user model(s). In Conkwright, a "user-model" refers a demographic-group or an interest-group that a user is in [column 35, lines 62 to column 38, lines 3]. For example, the column headings in Conkwright figure 22(a) are the demographic parameters of a Conkwright "user model" and the table's rows are filled with probabilities that are determined from the user interactions with the set-top box. In this way, Conkwright determines the group(s) that a user fits within.

For example, a "user model" may determine that a user is in "demographic group X" [column 36, lines 21-36]. Alternatively, a "user model" may determine that a user is in a group "those interested in home improvement" [column 37, line 16-24]. Therefore, Conkwright uses set top box events to determine one or more groups that a user is "probably" in.

In a separate process (boxes 2510 & 2511), Conkwright defines user attributes for each item of content . For example, an item of content might be designated as targeted for users in "demographic groups Y & Z" or users "interested in home improvement". In box 2521, the set top box selects content that is intended for the group(s) the user has been determined to be in. And in box 2522, the user is presented with content that is intend for the group(s) the user has been determined to be in.

In summary, Conkwright uses set top-box-events to determine the demographic group(s) or other group(s) that a user fits within; and then selects content arriving at a set-top-box that has been designated as targeted for those group(s) the user is in.

The applicant has throughly studied Conkwright and can find no disclosure, hint or suggestion that Conkwright tries to determine a user's rating that indicates the amount of preference of a user for a particular piece or composition.

Conkwright suffers many deficiencies that are similar to other prior art approaches that define a

user as fitting in a group or group(s). For example, in some prior art, the user may manually complete a profile or questionnaire, which is then used to place the user in a group(s).

Conkwright and these other prior art approaches assume that all users in a group have the same tastes. But there are only a limited number of groups. Yet each user has unique tastes. An individual may not like everything that a group is suppose to like. And, the user may like other things that are outside a defined group. Conkwright selects content that is targeted for the group(s) a user is in, but this content will not always be what an individual user likes.

Another problem with Conkwright is the use mathematical probabilities to determine the group(s) a user is in. With Conkwright, a user may be determined to be in the wrong group(s) and then that user will receive an even larger amount of content that the user does not like.

Another problem with Conkwright is that the type of content that is selected for the user will only change, if new set-top-box events were to cause the user to be determined to be in different group(s) than previously. For example, it may take a number of different set-top box events to cause a user to be removed from the "wrong" group(s) and to cause the user to be placed into the "right" group(s). Hence, Conkwright can only "coarsely" change the type of content that is selected for a user and only by determining that a user should be in a different group(s).

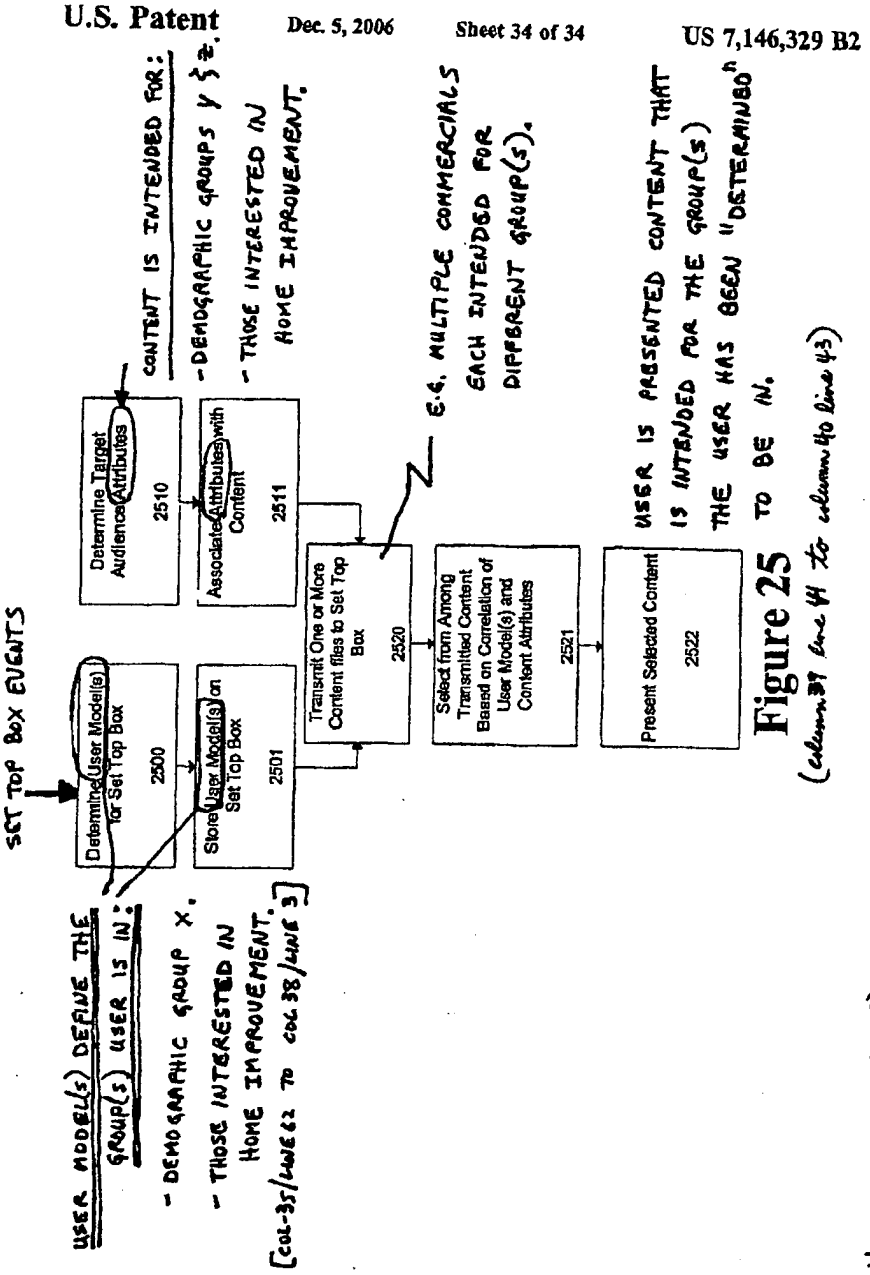

Figure 25

(column 37 line 44 to column 40 line 43)

"EXHIBIT A": "CONKWRIGHT" APPROACH

Claims overcome the 102 Rejections:

Claims Distinguish over Prior Art where the User Manually-Enters a 'User Profile":

In the "User Profile" systems of the cited art, the user may define a "profile" of the "types" of songs they prefer. First, the user must enter a "user-profile" entry/definition mode. Then, the user may manually enter/designate the type(s) or sub-type(s) of music; genre(s); sub-genre(s); or artist(s) that the user likes. Content which matches the manually-entered user's profile may then be selected for the user. Disadvantages of these prior art manually-entered user-profile approaches include:

- The user must have pre-knowledge of what these categories/classifications mean (e.g., "Blues" or the numerous sub-categories of "Blues") and the types of songs in the classifications.
- The classifications may be too broad for the user's tastes or the pre-defined standard classifications don't match a user's desired groupings.
- Because of classification limitations, the user is presented with many undesired songs and is not presented with songs that the user desires.

Hence, the cited art "Profile" systems require a more knowledgeable user; manual set-up/configuration by a user; and significantly burdens the user with the manual entry of additional information. The burden of manual entry may continue as a user's tastes change.

The applicant's claims distinguish over this type of prior art for at least the following reasons. This "user-profile" type of prior art does not have (at least) the applicant's claimed element/features "a user's rating for each piece or composition in a plurality of pieces or compositions; wherein a said user's rating represents an amount of preference of the user for a said piece or composition".

Claims Distinguish over Prior Art "Manual Playlist" Approaches:

In the Prior Art "Manual Playlist" Approaches, the user may manually build playlists. First, the user must enter a playlist definition mode and name the playlist. Then, the user must

manually designate each song, album or other playlist that should be included in the user's playlist. When the user wants to play that playlist at a later time, the user must "find" that playlist by name. Whenever the user's tastes change, the user must manually make each desired change to their playlist(s) or manually create a new playlist. Hence, the cited art "Manual Playlist" systems require a more knowledgeable user; manual set-up/configuration by a user; and significantly burdens the user with the manual entry of additional information. The burden of manual entry may continue as a user's tastes change.

The applicant's claims distinguish over this type of prior art for at least the following reasons. This "manual playlist" type of prior art does not have (at least) the applicant's claimed element/features "a user's rating for each piece or composition in a plurality of pieces or compositions; wherein a said user's rating represents an amount of preference of the user for a said piece or composition".

Claims Distinguish over Prior Art where the User Manually enters a Rating:

The applicant's specification, in paragraphs 14 and 16, discusses other prior art where the user may use an interactive display to manually enter a rating or a preference for each individual composition. In the "Rating" systems of the Apple iTunes (cited in the Office Action) and other cited art, the user is required to perform an very large amount of manual data entry. Typically, the user must manually input their rating for each song. For example, in iTunes, the user must manually select from one to 5 stars to indicate their rating for each song.

As noted in the applicant's specification, the disadvantages of requiring the user to manually rate compositions include:

a) the user's vision must be good enough the to view the visual display.

b) the user may need to read instructions which may be in a foreign language or foreign character/symbol set.

c) the user may need to operate a mouse or other pointing device to enter their rating in the interactive display.

d) in many user situations (e.g., auto) it may be unsafe for a user to view and interact with a visual display.

e) the user may need to navigate display pop-ups or display windows and the user may need to take additional actions to rate each composition.

f) the user needs to be familiar with the "meaning" of the rating system scale that is being used. For example, is the rating system positive or negative orientated? What is being rated (song; album; artist)? Are more stars better/worse or is one star the best/worst? Is a higher number better/worse? Is the number one the best/ worst or is the highest number the best/worse?

g) the user must consistently set the rating for one composition versus others within the rating scale. (e.g., so all compositions marked with 4 of 5 stars will have a same level of likability).

h) the user may have to rate a very large number or even all of their songs in their collection before the rating system is able to provide acceptable results.

i) the user must group their ratings in a way that they can be sorted by a playlist selector based on their chosen ratings (e.g., create a playlist of 5 star songs). After rating many songs, the user may then discover their rating numbering/ordering does not result in suitable playlists from being created by the playlist generator.

j) the user must manually change their rating for each song whenever their taste changes.

Hence, the cited art "Rating" systems: require a more knowledgeable user; manual set-up/configuration by a user; and significantly burdens the user with the manual entry of additional information. The burden of manual entry may continue as a user's tastes change.

Note that in these prior art manual rating methods, the current playback of a composition is not affected when the user manually enters their rating. The applicant's claims distinguish over this type of prior art for at least the following reasons. This "manual rating" type of prior art does not have (at least) the applicant's claimed element/features "affect the current playback of a piece or composition" and "a said user's rating was determined by using said details of previous said control actions by said user".

Claims are not an Automation of a Method Previously Preformed by Humans:

The Office has previously asserted that the claims are an automation of a method that was previously performed by humans. The applicant traverses this assertion for at least the reasons below (and for the reasons discussed in prior applicant's replies):

As shown in "Exhibit B" a user may develop an"internal" preference in their "mind" for how they feel after experiencing a composition. For example, a user may "really like" one composition. And the user may "really dislike" another composition. The user's preferences for compositions may also change over time.

Consider a user who doesn't like a certain type of music (e.g., country music). When the user hears a country music composition, the user may take action in-order to avoid the country music composition. For example, the user might press the forward button in-order to skip the rest of a currently playing country music composition. Note, that the user first "realized" that they did not like the composition (i.e., the user determined their preference for the composition) and then, the user took action to avoid the composition. Notice that, the user first established their preference and then based on that preference, the user took action (e.g., pressing the forward button).

But notice that the user did not think in their mind:

1) I just pressed the forward button to skip the rest of the currently playing composition.

2) that may mean I don't like that composition.

3) therefore I should lower my preference for that composition, because I pressed the forward button.

Note that, the cause-effect relationship of the human process (e.g., establish preference then take action) is different from that of the applicant's claims (e.g., utilize actions taken to determine preference).

Also notice, that through repetition/habit the user may get better at detecting compositions that they don't like. And through repetition/habit the user may get faster at taking

action (e.g., pressing the forward button). But still notice that the user still determines their preference first and then takes action. Again note that, the cause-effect relationship of the human process is different from that of the applicant's claims.

Note that, the prior human process does not really notice/monitor/record the user's control actions. And the prior human process does not then utilize those "noted" user's control actions to determine or update the user's preference for a piece or composition. The cause-effect relationship of the human process (e.g., establish preference then take action) is different from that of the applicant's claims (e.g., utilize actions taken to determine preference).

Hence, for at least the above reasons, the claims have not been performed by a prior human process; and hence, are not an automation of a prior human process.

Claims overcome the 102 Rejections ("Conkwright"):

Claims 163 [Independent Claim]:

The independent claims were rejected under 102 as being anticipated by "Conkwright" (7,146,329). The applicant traverses the rejection for at least the reasons discussed below.

The Office Action (page 5) , asserts that Conkwright Col. 41, lines 1-12, "deriving at least one user model" is equivalent to the applicant's claimed element/features. Applicant disagrees with the asserted equivalence, for at least the following reasons:

1) Applicant agrees that Conkwright does use set top box events to determine user model(s). But in Conkwright, a "user-model" refers to the demographic-group(s) or an interest-group(s) that a user is in [column 35, lines 62 to column 38, lines 3]. The column headings in Conkwright figure 22(a) are an example of the demographic parameters in a Conkwright "user model". Conkwright uses set-top box events to calculate the probability that the user fits each demographic parameter of figure 22(a). In this way, Conkwright determines the group(s) that a user "probably" fits within.

   For example, in Conkwright , a "user model" may define that a user is in "demographic group X" (column 36, lines 21-36). Alternatively, a "user model" may define that a user is in the group of "those interested in home improvement" [column 37, line 16-24]. Therefore, Conkwright uses set top box events to determine user-models that define the one or more groups that a user is "probably" in.

   Contrary to the Office Action assertion, the usage of the term "user-model" in Conkwright is not related to the determination of a user's rating (the amount of a user's preference for a particular piece or composition). Hence, for the above reasons, the Office Action assertion of the equivalence of Conkwright's user-model with the applicant's claim element/feature is incorrect.

2) The applicant performed a text-search for the words "rating or rating" in a text-

searchable version of the Conkwright patent, available on the USPTO website. In each paragraph where "rating or rating" was used in Conkwright, the use was limited to an aggregate rating of a group. For example:

Neilsen ratings.

Group ratings of future programs.

Ratings predictions of commercials and programs for specific demographic groups.

Ratings for geographic areas or time periods or demographic characterizations.

Ratings for demographic specification group.

3) The applicant performed a text-search for the words "preference or preferences" in a text-searchable version of the Conkwright patent available on the USPTO website. The use of "preference" was not found. "Preferences" was used in only two paragraphs. When reading the full context as used in these paragraphs and the complete Conkwright specification, the use of "preferences" was limited to groups:

"preferences associated with a geographically based group of people"

"to make content more appealing to a particular audience".

4) In addition to the above, the applicant has throughly studied Conkwright and can find no disclosure, hint or suggestion that Conkwright tries to determine a user's rating that indicates the amount of preference of a user for a particular piece or composition.

In addition, each of the other cited art do not individually contain all of the elements/features in the amended independent claims. Therefore, for at least these reasons, the new claims overcome the 102 rejections.

Claims 164-179:

Claims 164-179 depend from claim 163 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 163, are neither disclosed nor suggested in the references cited and applied by the Office.

Claims overcome the 103 Rejections:

Independent Claims 163, 181, 185 and 203:

The Office action (page 11-12) rejected the 4 independent claims [163, 181, 185 and 203] under USC 103(a) as being unpatentable over Admitted Prior Art (APA) in view of In re Venner, 120 USPQ 192 (CCPA 1958), In re Rundell, 9 USPQ 220 and Wahid "How Habits are Formed by our Mind". The applicant traverses this rejection for at least the following reasons:

1) The cited article by Wahid ("How Habits are Formed by Our Mind") was dated 27 Oct 2006 which is well after the Applicant's filing date of Nov 3, 2003 and is therefore unsuitable for use as a cited art publication in 102 and/or 103 arguments.
2) The Office Action notes the "APA does not appear to expressly disclose selecting automatically, at least one entertainment piece or composition for a user based on said updated user's ratings (preferences)". The Office Action discusses human behavior and habits in Wahid but the Office action does not show where this missing element can be found Wahid.
3) The Office Action only states where some of the elements (but not all the claimed elements) can be found in the individual references. The Office Action does not provide a rational for why it would be obvious, for someone skilled in the art, to combine together the different elements/features found in the different references in-order to obtain the applicant's claimed invention. Hence, the Office action has not established a prima facie case of obviousness per MPEP 2141 through 2145.
4) The Office Action asserts the claims are "no more than an automation of a process typically performed by hand". Applicant traverses this assertion for at least the reasons described in the section of this amendment entitled: "The Claims are not an Automation of a Method Previously Preformed by Humans".

Claims 164 and 186:

The Office Action asserts "these actions are being monitored by the users brain and

cannot be performed without active participation and recognition of the event". Applicant traverses this assertion for at least the reasons described in the section of this amendment entitled: "Claims are not an Automation of a Method Previously Preformed by Humans".

Specifically for this claim, consider a user who uses the "back" button (perhaps several times) to re-hear a composition they recently heard. Note that, the user establishes a preference first and then based on that preference, the user took action. But notice that the user did not think in their mind:

1) I just pressed the back button to hear a previously played composition again.

2) that may mean I like that composition.

3) therefore I should raise my preference for that composition, because I pressed the back button.

In reality, the user first established their preference for a composition then the user took action (e.g., pressing the back button). Note that, the prior human process does not really notice/monitor/record the user's control actions. And the prior human process does not then utilize those "noted" user's control actions to determine or update the user's rating for a piece or composition.

Claims 165, 166, 167, and 187, 188, 189:

The applicant traverses the rejection for at least the following reasons:

1. The cited article by Wahid ("How Habits are Formed by Our Mind") was dated 27 Oct 2006 which is well after the Applicant's filing date of Nov 3, 2003 and is therefore unsuitable for use as a cited art publication in 102 and/or 103 arguments.
2. The Office action does not show where the element of the dependent claim can be found Wahid. The Office Action only generally discusses human behavior and habits in Wahid.
3. The Office Action only states where each of the elements/features can be found in the individual references. The Office Action does not provide a rational for why it would be obvious, for someone skilled in the art, to combine together the different elements found in the different references in-order to obtain the applicant's claimed invention. Hence,

the Office action has not established a prima facie case of obviousness per MPEP 2141 through 2145.

4. The Office Action asserts the claims are done by "human mind". Applicant traverses this assertion for at least the reasons described in the section of this amendment entitled: "The Claims are not an Automation of a Method Previously Preformed by Humans".

Claims 168 and 190:

The Office asserted obviousness per Conkwright Col. 2 lines 2-5: "intentionally leaving the television 'on' to a certain channel to insure higher ratings ...". The applicant traverses the rejection for at least the following reasons.

In these section, Conkwright describes user behavior intended to fool the Neilsen ratings: by keeping a user's favorite show 'on', even though the user is not watching it, in-order to help their favorite show obtain a higher Neilsen rating.

Note that, for this type of user behavior, the user does not take action and hence there are no "user control actions" as in the applicant's claims. Also note this type of user behavior has no connection with how "soon" the user takes control action or actions. Therefore, for at least the above reasons, the cited Conkwright discussion is not related to the applicant's claims.

Claims 169 and 191:

The Office asserted obviousness per Conkwright Col. 31 lines 55+. The applicant traverses the rejection for at least the following reasons:

The applicant's specific claimed feature "after said user has experienced said avoided piece or composition for at least a recognition-time" does not appear in the cited section of Conkwright. Office has not shown where Conkwright discloses the use of a "user's recognition time" as claimed by the applicant.

Therefore, for at least the above reasons, the cited Conkwright discussion is not related to the applicant's claims.

Claims 170 and 192:

The Office action rejected claims 170 and 192 under USC 103(a) as being unpatentable over Admitted Prior Art (APA) as modified and applied to claims 163-169, 171, 174-191, 193 and 196-205 and further in view of "Name that Tune" from Wikipedia. The applicant traverses this rejection for at least the following reasons:

1) The cited Wikipedia article ("Name that Tune") was dated 9/26/2008 ["Wikipedia history" shows that the date of the earliest version is 27 January, 2004] which is after the Applicant's filing date of Nov 3, 2003 and is therefore unsuitable for use as a cited art publication for use in the examiner's 102 and/or 103 arguments.
2) In addition, Wikipedia can be edited in an arbitrary or erroneous manner; at anytime, by anyone in the general public who accesses the Wikipedia website. Although arbitrary and/or erroneous edits may be later corrected by more responsible members of Wikipedia; this depends on the frequency the article is monitored and corrected by other Wikipedia members. Hence, the Wikipedia website can not be relied upon to be accurate when accessed at any one instant in time.
3) Even if one assumes that "Name that Tune" was an old and well known game, the show only tested how quickly contestants could both recognize a song and to recall the name of the song. But, how quickly a contestant can "name a tune" is unrelated to a contestant's preference for that song/music.
4) "Name that Tune" has nothing to do with a user's preference for a composition. A contestant could either like or dislike a song that they can "name". For example, the contestant may be able to name a song that they "really dislike", because they have hear it way too many times. Hence, the Office Action has failed to establish that "Name that Tune" is in any way related to the applicant's claims for determining a user's rating/preference for a composition.
5) Note that, a user only needs to experience the composition to determine their preference for the composition. Even if they have never heard or can't recall a composition's "name", a user can decide whether they like or dislike a composition ... just by experiencing it.

6) The Office Action states that it would be obvious "to have a higher rating for faster behavior". But notice that in the applicant's specification, the faster a user takes action to avoid a composition, the more the user's preference is lowered (i.e., not raised as suggested in the Office Action rationale). Hence, the applicant's invention works in an different manner from rationale used in the Office Action.
7) The Office Action does not provide a rational for why it would be obvious, for someone skilled in the art, to combine together the different features/elements found in the different references in-order to obtain the applicant's claimed invention. Hence, the Office action has not established a prima facie case of obviousness per MPEP 2141 through 2145.

Claims 171 and 193:

The Office Action referred to "Wahid" with a discussion of "Habits". But the Office Action did not show where each of the claimed element/features can be found in the prior art. In particular, where a user's rating (amount of preference) is "based on a plurality of said user control actions that occurred on a plurality of different occasions; wherein said control actions were applied to the same piece or composition".

In addition, the Office Action does not provide a rational for why it would be obvious, for someone skilled in the art, to combine together the different features/elements found in the different references in-order to obtain the applicant's claimed invention. Hence, the Office action has not established a prima facie case of obviousness per MPEP 2141 through 2145.

Claims 174 and 196:

The Office Action asserts that "paragraph 16 of the specification discloses "the use of ratings to determine play sequence" and "that the higher the rating the greater the chance a selection will be played sooner rather than later". Applicant traverses this assertion for at least the following reasons. Careful reading of paragraph 14 shows that neither of these statements are shown or stated or implied in indicated in paragraph 16. The paragraph states "the user manually rates each composition based on a scale, such as 1 to 100". In actuality, paragraph 16

does not provide any indication about how the manually entered ratings are utilized.

In addition, the Office action has not established a prima facie case of obviousness per MPEP 2141 through 2145. The Office Action does not provide a rational for why it would be obvious, for someone skilled in the art, to combine together the different elements found in the different references in-order to obtain the applicant's claimed invention.

Claims 175, 176 and 197, 198:

The Office Action asserts that "paragraph 14 of the specification as filed show that the use of ratings in determining determining playback sequence". Applicant traverses this assertion for at least the following reasons. Careful reading of paragraph 14 shows that this is not shown or stated in paragraph 14. Paragraph 14 actually indicates that songs are "selected based upon the user's profile" and "each user creates a unique profile using a interactive windows application on the PC in-order to select music categories and artists the user likes".

The Office Action also asserts that "Yahoo, Launchcast which performs the exact same method applicant is attempting to claim". Applicant traverses this assertion for at least the following reasons. Yahoo, Launchcast is an example of prior art where the user manually enters a rating on an interactive display. How the applicant's claims differ from the cited-art manual rating approaches is described in detail in the section above entitled: "Claims Distinguish over Prior Art where the User Manually enters a Rating".

In addition, the Office action has not established a prima facie case of obviousness per MPEP 2141 through 2145. The Office Action does not provide a rational for why it would be obvious, for someone skilled in the art, to combine together the different elements found in the different references in-order to obtain the applicant's claimed invention.

Claims 177 and 199:

The Office Action asserts that paragraph 16 of the specification discloses applicant's claims. Applicant traverses this assertion for at least the following reasons.

The applicant's specification, in paragraphs 14 and 16, discusses other prior art where the user may use an interactive display to manually enter a rating or a preference for each

individual composition. For example, the user may view a display that allows the user to manually enter or select a number that represents the user's preference for a displayed composition. For example, the user might manually select 4.5 of 5 stars on a display to indicate their preference for the shown composition. As noted in paragraphs 16 and 119 of the applicant's specification, the disadvantages of requiring the user to manually rate compositions include:

k) the user must view a visual display and may need to navigate display pop-ups or display windows.

l) the user may need to operate a mouse or other pointing device to enter their rating in the interactive display.

m) in many user situations (e.g., auto) it may be unsafe for a user to view and interact with a visual display.

n) the user needs to take additional actions to rate each composition.

o) the user needs to be familiar with the "meaning" of the rating system scale that is being used. (e.g., is a 1 or is a 10 better?)

p) The user must consistently set the rating for one composition versus others within the rating scale. (e.g., so all compositions marked with 4 of 5 stars will have a same level of likability).

q) The user must manually change the rating for each composition as their tastes change over time.

Note that in these prior art manual rating methods, the playback of a composition which might be playing is not affected when the user is manually entering their rating. Hence, with the prior art manual rating methods, when the user is manually entering a rating, the user is not performing "control action(s) that are affecting the playback of a composition.

Also note, that with the prior art manual rating methods, only the latest value that was manually-entered by the user is used as the rating and the previous manually-entered values are not used. Hence, the manual prior art does not have the following applicant claimed feature:

"wherein a said user's rating can be determined using said saved history of details of a plurality of said user's control actions".

Claim 178, 182, 200, 204 and 179, 189, 201, 205:

The Office asserts that "radio/television stations continue to play music with and without listener guidance and input. That is, the station does not go off the air because no one is listening/watching". The applicant traverses the rejection for at least the following reasons.

Radio/television stations do not custom select programming for the user. In addition, radio/television stations do not custom select programming for the user by using said user's ratings. Hence, Office has not shown where the above features are in the applicant's claims are in the prior art radio/television stations.

In addition, the Office Action does not provide a rational for why it would be obvious, for someone skilled in the art, to combine together the different features/elements found in the different references in-order to obtain the applicant's claimed invention. Hence, the Office has not established a prima facie case of obviousness per MPEP 2141 through 2145.

Claims overcome "Conkwright" further in view of either Cohen or Fanning:

Discussion of Cited Art "Fanning" and "Cohen":

The iTunes "Smart playlists" (cited art "Fanning" and "Cohen") are very complex to setup and use (compared with the applicant's invention). First the user must know that "Smart playlists" capabilities exist within the iTunes and must know the correct menu selections to make on a computer interface to even enter the "Smart playlists" definition mode. Then, the user must create a name for a smart playlist. Then, to define a "Smart playlist", the user must then make numerous selections on pulldown menus and/or checkboxes, etc; of which there are probably thousands of possible combinations that may be used to define a "Smart playlist".

To play songs using the playlist at some later time, the user must remember the created name of the "Smart playlist" and what it does and then locate the previously defined "Smart playlist" name in the iTunes system. In addition, many "normal" user actions may cause an exit

from the currently active Smart playlist": (e.g., user action to cause a specific song to play that is not in the current 'Smart playlist").

The Apple iTunes Smart-Playlist parameter "Play count", which is the number of times a song has been played, is not representative of a user's current preference. A song with a high "Play count", may have been heard so many times by the user that the user is tired of hearing that song and may not want to hear that song again. Alternatively, a song with a high "Play count" may still remain one of the user's current favorites and the user still wants to hear it frequently. In addition, unlike the applicant's invention; the Apple iTunes "Play count" does not distinguish between user action to play a specific song (a strong indicator of user interest) and a non-user initiated playback of the song by a user playback device (a limited indicator by itself). In addition, unlike the applicant's invention, a simple "Play count" does not distinguish between the number of times a song was initiated and the number of times the song played completely or partially and the details of partial playbacks. Hence, the "play count" is a combination of user and non-user events.

Similarly, the iTunes Smart-Playlist parameter "Last played" (cited in the Office Action); which is the date/time a song was last played; is not representative of a user's preference. The Apple iTunes "Last played" does not distinguish between when there was user action to play a specific song (a strong indicator of user interest) and a non-user initiated playback of the song by a user playback device (a limited indicator by itself). Hence, "last Played" may be a use or non-user event. In addition, a simple "Last Played" does not distinguish between complete and partial playbacks and the details of partial playback.

Additional disadvantages of the iTunes "Smart Playlist" include requiring a more knowledgeable user; manual set-up/configuration by a user; and significantly burdening the user with the manual entry of additional information. The burden of manual entry may continue as a user's tastes change.

Discussion of "Conkwright" further in view of either Cohen or Fanning:

Office Action had rejected claims 163-169, 171, 174-191, 193 and 196-205 under 103(a) "as being unpatentable over Conkwright ... further in view of either Cohn or Fanning. The applicant traverses the rejection for at least the following reasons.

1) The Office Action indicates that "repeat or replay" is not disclosed in Conkwright. The Office makes a general assertion of equivalence of features. But the Office Action fails to specifically point out where "repeat or replay" is disclosed in Fanning and Cohen. Even if the specific elements could be found in Fanning and Cohen, applicant respectfully traverses the rational for combining these references.

2) "Conkwright" is described in detail in the above sections entitled: "Conkwright Reference" and "Claims overcome the 102 Rejections (Conkwright)". As explained in these sections, Conkwright

- Conkwright uses set top-box-events to determine the demographic group(s) or other group(s) that a user fits within; and then

- Conkwright selects content arriving at a set-top-box that has been designated as targeted for those group(s) the user is in.

But "Conkwright" does not determine a user's rating "wherein a said user's rating represents an amount of preference of the user for a said piece or composition"

3) Even if one was able to combine Fanning and Cohen (playcount; last played) to Conkwright; that combination of references would only, per Conkwright, be using additional set-top-box events to determine which group(s) a user is in. But, this combination of references would still not determine a user's rating "wherein a said user's rating represents an amount of preference of the user for a said piece or composition". Hence, combining these references does not result in the applicant's claimed invention.

The Office Action had rejected claims 171, 174-191, 193 and 196-199 under 103(a) [Fanning & Cohen applied to Conkwright]. The applicant traverses the rejection for at least the following reasons.

As disclosed in Fanning, the iTunes "My Rating" allows the user to manually "rate each track with a score out of five stars". As disclosed in Fanning, with iTunes the user can create a "Smart Playlists(s)" based on the "My ratings"; playcount; last played;

etc.

But Fanning does not disclose that when a user selects a "smart playlist" for playback, that the frequency that a song (in the "smart playlist") is played is influenced by the "My ratings"; playcount; last played; etc. Hence, the Office has not shown where this specific feature/limitation is located in the cited art.

Even if the specific elements could be found in Fanning and Cohen, applicant respectfully traverses the rational for combining these references for at least the following reasons. Even if one was able to combine Fanning and Cohen (playcount; last played) to Conkwright; that combination of references would only, per Conkwright, be using additional set-top-box events to determine which group(s) a user is in. But, this combination of references would still not determine a user's rating "wherein a said user's rating represents an amount of preference of the user for a said piece or composition". Hence, combining these references does not result in the applicant's claimed invention and a 103 rejection is not proper.

Summary:

The applicant has written simpler and clearer claims. Claims 163-179 and 206-231 are pending. To allow for the added new claims 206-231; claims 180-205 have been canceled without prejudice. The number of independent claims and the number of total claims has not changed.

The applicant believes all the claims are in condition for allowance. The applicant respectfully requests that a timely Notice of Allowance be issued in this case. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the Applicant.

Respectfully submitted,

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